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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,074

09/26/2003

Randall Heath

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SMITH, GAMBRELL & RUSSELL  
SUITE 3100, PROMENADE II  
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ATLANTA, GA 30309-3592

EXAMINER

SAFAVI, MICHAEL

ART UNIT

PAPER NUMBER

3637

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/673,074	<b>Applicant(s)</b> HEATH, RANDALL	
	<b>Examiner</b> Michael Safavi	<b>Art Unit</b> 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/3/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Reissue Declaration***

The reissue oath/declaration filed with this application, (including the declaration filed March 03, 2009), is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration references an amendment of May 05, 2005 when the submission of May 05 2005 has not been entered as failing to comply with 37 CFR 1.173. The amendment of October 24, 2007 has been entered.

Further, The supplemental reissue oath/declaration filed with this application on March 03, 2009 is defective because it fails to set forth that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The supplemental declaration of March 03, 2009 states “by reason of the patentee claiming more or less than he had the right to claim in the patent.” However, by this statement the supplemental declaration does not set forth whether patentee claimed more than he had the right to claim in the patent or whether patentee claimed less than he had the right to claim in the patent or whether patentee claimed more as well as less than he had the right to claim in the patent. The statement within line 18 of the supplemental declaration appears ambiguous if not contradictory to the statement presented at lines 22, 27, and 32 of the supplemental declaration.

***Claim Rejections - 35 USC § 251***

Claims 1-10 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 251***

Claim 10 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The language/limitations presented within claim 10 deletes a limitation or limitations which had been presented within claims as by amendments, as well as

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argued as a basis for patentability over the applied and cited prior art, filed in response to rejections of claims 1, 7-9, and 11-15 of the issued patent no. 6,324,796.

Claim 10 cancels limitations to --a series of longitudinally extending lands and crests-- as had been inserted by amendment within claim 1 during prosecution of application serial no. 09/546,869 in order to place the application in condition for allowance.

As such, Applicant's introduction of instant claim 10 in the present reissue application would constitute an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-10 of U.S. Patent No. 7,047,697.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-10 are generic to all that is recited within claims 2-10 of U.S. Patent No. 7,047,697. In other words, claims 2-10 of U.S. Patent No. 7,047,697 fully encompass the subject matter of claims 2-10 and therefore anticipate claims 2-10. Since claims 2-10 are anticipated by claims 2-10 of the patent, they are not patentably distinct from claims 2-10 of U.S. Patent No. 7,047,697. Thus, the invention of claims 2-10 of the patent is in effect a “species” of the “generic” invention of claims 2-10. It has been held that the generic invention is anticipated by the species, see *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 2-10 are fully anticipated, (fully encompassed), by claims 2-10 of the patent, claims 2-10 are not patentably distinct from claims 2-10 of U.S. Patent No. 7,188,736, regardless of any additional subject matter present in claims 2-10.

### ***Response to Arguments***

Applicant's arguments filed March 03, 2009 have been fully considered but they are not persuasive. By rewriting original claim 10 in independent form Applicant at the time has surrendered any version of claim 10 that does not specifically include all of the language of the limitation in question (within paragraph d namely, “a series of longitudinally extending lands and crests”). By Applicant broadening paragraph d of claim 10, Applicant has triggered recapture. It does not matter that the deleted

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language had been present in the original application all along or that the examiner had originally objected to the language of originally filed claim 10.

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,324,796 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on March 03, 2009 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Michael Safavi/  
Primary Examiner, Art Unit 3637

M. Safavi  
March 27, 2009